



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087802,472	02/18/97	KURBANIK	

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QM21/0219

EXAMINER
LOBY, M

ART UNIT	PAPER NUMBER
3721	9

DATE MAILED: 02/19/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/802,472

Applicant(s)

Kormanik, Jr.

Examiner

Matthew Luby

Group Art Unit

3721



☒ Responsive to communication(s) filed on Feb 18, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 1-4 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 5-24 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-24 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Feb 18, 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3721

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a method of making a protective sleeve, classified in class 493, subclass 243.
  - II. Claims 5-24, drawn to a method for making packaging, classified in class 53, subclass 467.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claim 1 is directed towards a method for making a protective sleeve provided with first and second flaps, first and second lips and multiple joints. The subcombination has separate utility such as a method for making a package without first and second flaps, first and second lips and multiple. This is suggested by the claims 5-24 which are directed towards a method for making a package which symbolizes some activity or function and then placing an article which is relative to that activity into the package. The subcombination claims do not recite any flaps, lips or joints. Claim 5 is an

Art Unit: 3721

evidence claimed which indicates that the combination does not rely upon the specific details of the subcombination for its patentability.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Peter Tryzna on February 2, 1999 a provisional election was made without traverse to prosecute the invention of Group II, claims 5-24.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-4 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

5. New formal drawings are required in this application because the drawings are too light to show any line or reference number fully. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "54" has been used to designate both a "hemispheric halve" and a "box" (see page 12). Correction is required.

Art Unit: 3721

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 36. Correction is required.

8. The drawings are objected to under 37 CFR 1.83(a) because they fail to show “locating rain gear, as the article, within the hollow of the replica” as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

***Claim Rejections - 35 USC § 112***

9. Claims 5-23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites “constructing essentially a replica of a symbol having a shape that is suggestive of an activity”. It is unclear how the word “essentially” should limit the claim. The claim is not directed towards “constructing...a replica of a symbol”, but rather making a package which resembles a ball or some other tangible object. Symbols include such things as crosses or letters, which are not described in the specification nor shown in the drawing. The recitation “a shape that is suggestive of an activity” is vague and indefinite. Any shape could be “suggestive of an activity.” Claim 22 is vague and indefinite for failing to point out what “constructing ...to be capable of receiving writing”. Anything that has a surface could receive writing.

Art Unit: 3721

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 5, 8, 9 and 11-14, 16, 18-21 and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gelinas, Jr. Gelinas, Jr. discloses a method of making a package which has an article located inside, where the package includes an outer layer of packaging "suggestive of an activity" and where the package is a replica of a golf ball, baseball, football, tennis ball, soccer ball or rugby ball (Figures 1-9).

12. Claims 5, 17 and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Agapiou. Agapiou discloses a method for making a package which has an article located inside, where the package is "suggestive of an activity", where the package has a logo on the replica (30, 10) and constructing the package to be capable of receiving writing (Fig. 1).

13. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Danforth. Danforth discloses a method for making packaging including the steps of providing an object in a container, where the container resembles a ball (10, Figs. 1-3) and the object is a hat (14), so that the ball is

Art Unit: 3721

openable to remove the hat for use. The ball would suggest the activity of using the hat (14) since it can be clearly seen that there is a hat (14) in the ball (Fig. 1).

14. Claim 24 is rejected under 35 U.S.C. 102(e) as being anticipated by Gilstrap. Gilstrap discloses a method for making packaging including the steps of providing an object in a container, where the container resembles a ball (Fig. 3D) and the object is a hat (20), so that the ball is openable to remove the hat for use (Figs. 3A-3C). The ball would suggest the activity of using the hat because the user would know that inside the ball there was a hat.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 5, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swatek. Swatek discloses a method of making a package which has an article located inside, where the package is "suggestive of an activity" and where the package is a replica of a first aid item. Swatek does not disclose that the package is a replica of a charge card or that the package is a replica of a life preserver. It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the shape of the replica of the package, as is suggested by the applicant's various claims to different shapes, to a charge card or life preserver. Changing the shape of the replica merely suggests that the package can be representative of any activity, as

Art Unit: 3721

is clearly suggested in claim 5. Therefore it would have been a mere matter of design choice to change the replica shape to a life preserver or charge card.

***Allowable Subject Matter***

17. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

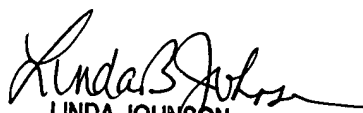
***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on the attached Form 892.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Luby whose telephone number is (703) 305-0441. The examiner can normally be reached Monday to Friday from 8:30 a.m. until 5:30 p.m. EST. Any questions of a general nature pertaining to the application can be directed to the group receptionist whose number is (703) 308-1148.

m.l.

February 5, 1999

  
LINDA JOHNSON  
PRIMARY EXAMINER  
GROUP 3721